

REMARKS/ARGUMENTS

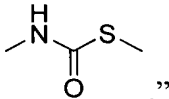
Claims 1-17 remain cancelled.

Claims 18-39 remain pending.

No new matter has been added.

The obviousness rejection of Claims 18-39 as being unpatentable in view of Haberle and Horodysky is respectfully traversed because the references, either alone or in combination, do not describe or suggest all of the features of the present claims.

Present Claim 18 is drawn to "A thiocarbamide comprising at least one carbodiimide

group and at least one thiocarbamic ester group of the formula .

The Office, at page 2 of the Official Action, describes that "Haberle et al. fails to teach a thiocarbamic ester group (-HN-CO-S-) in their carbodiimide derivative."

The Office therefore relies on Horodysky to supply the thiocarbamic ester group.

At the outset, Applicants note that MPEP 2111.01 IV, describes, in part, "An applicant is entitled to be his or her own lexicographer." Thus, in a patent application, an applicant can use a term and define the term, subject to certain restrictions found in the MPEP.

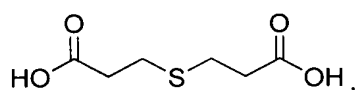
The Abstract of Horodysky describes, in part, "ashless dispersants containing integral sulfur-ester moieties..." So the question then becomes what is an "integral sulfur-ester moiety" as defined by Horodysky as lexicographer?

The Office, at page 2 of the Official Action, cites Column 1, lines 43-45, of Horodysky to supply sulfur ester moieties. Applicants respectfully submit that Horodysky has been misconstrued by the Office.

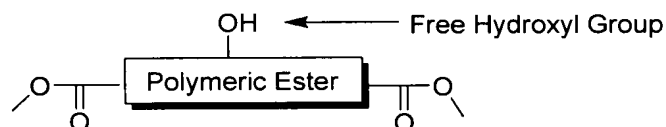
Column 1, under Summary of the Invention, Horodysky describes, in part, that "The sulfur-ester moieties can be introduced in many ways such as ... (B) reaction of (1)

preformed polymer ester dispersant with (2) relatively small amounts of sulfur containing acid such as 3,3'-thiodipropionic acid." Horodysky further describes "These preformed ashless dispersants include any polymeric acid ...reacted with a polyol...to yield polymeric ester containing at least one free OH group available for reaction with sulfur containing acid or acid generating species" (See Horodysky, column 1, lines 35-61).

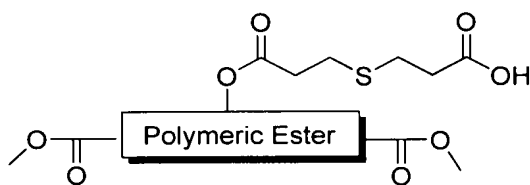
Applicants note that the structure of 3,3'-thiodipropionic acid is:



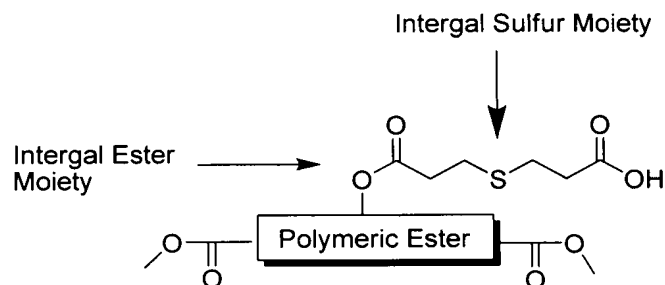
Applicants further depict, for purposes of this argument, a "polymeric ester containing at least one free OH group available for reaction with sulfur containing acid" as:



Thus, to form his "ashless dispersants containing intergal sulfur ester moieties," Horodysky reacts, for example, 3,3'-thiodipropionic acid with a "polymeric ester containing at least one free OH group" to obtain the following product:



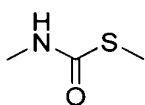
Applicants note that this product contains both an integral sulfur moiety and an integral ester moiety:



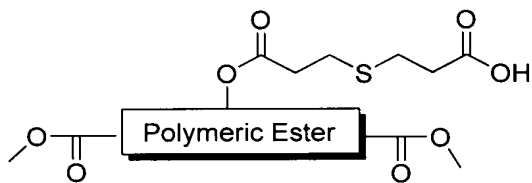
, and as such, is, according to Horodysky, a compound having an “integral sulfur-ester moiety.”

Applicants further note this characterization of Horodysky is supported, for example, by Table 1, at column 4, Example 1 of Horodysky that describes, “Polymeric ester treated with thiodipropionic acid” and at Table 2, column 4, Example 1 of Horodysky that “Polymeric ester treated with thiodipropionic acid.”

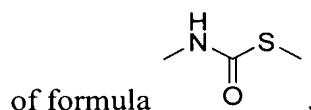
Accordingly, although Horodysky describes “ashless dispersants containing integral sulfur ester moieties,” Horodysky does not describe or suggest compounds of formula



. Rather, Horodysky describes compounds represented by



. Further, Horodysky is not enabled for compounds



Horodysky and Haberle thus do not describe or suggest, and are not enabled for, all of the features of present Claim 18 and the claims depending therefrom. Withdrawal of the obviousness rejection is respectfully requested.

Further, the Office, at page 2 of the Official Action, has described that “sulfur ester moieties possess significantly improved thermal and oxidative stability properties when compared to their non-sulfur ester containing analogs.” The Office has cited column 1, lines 43-45 of Horodysky, to support this assertion.

Applicants respectfully submit the Office has again mischaracterized Horodysky.

Applicants submit that Horodysky does not describe or suggest anything about improved thermal and oxidative stability properties of sulfur ester moieties when compared to their non-sulfur ester containing analogs, and that Horodysky actually suggests just the opposite.

As is evident from Example 1 of Horodysky, the sulfur containing compound is an additive to a paraffinic lubricating oil. Without being bound by theory, Applicants submit that the sulfur containing compound additive acts as an antioxidant for the lubricating oil because the sulfur atom of the sulfur ether in the sulfur containing additive is more readily oxidized than the paraffinic lubricating oil. Thus, Applicants submit the sulfur containing additive is more effective in stabilizing the lubricating oil, when compared to the non-sulfur containing additive, because the sulfur containing additive is itself less stable (e.g., is more readily oxidized) than the comparative non-sulfur containing additive of Example 2 in Table 1 of Horodysky.

Thus, it is the stability of the lubricating oil that is increased, not the stability of the additive. Indeed, the stability of the sulfur containing additive, when compared to the non-sulfur containing additive, is less / decreased because the sulfur atom in the sulfur ether of the sulfur containing additive of Example 1 of Table 1 of Horodysky is more easily oxidized than the non-sulfur containing additive of Example 2 of Table 1 of Horodysky.

Finally, at page 3 of the Official Action, the Office has stated "The applicant has made allegations to unexpected results. Those being an improved peel strength and thermal stability. These are not unexpected since one of ordinary skill in the art would expect an increase in thermal stability, and hence peel strength under increased temperature, when a sulfur ester was used instead of a non-sulfur ester."

Applicants respectfully submit this line of reasoning by the Office is incorrect. As described above, Horodysky describes thermal stability of lubricating oils under oxidative conditions. Horodysky is silent about non-oxidative thermal stability. Further, Horodysky is silent about adhesive strength and the effect of thiocarbamic groups. Indeed, Horodysky, as described above, does not describe or suggest thiocarbamic groups, and Horodysky is not enabled for thiocarbamic groups.

The obviousness rejection must be withdrawn.

Applicants submit the present application is now in condition for allowance. Early notification to this effect is earnestly solicited.

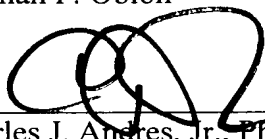
Respectfully submitted,

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